

## REMARKS/ARGUMENTS

Claims 1-10 were pending. Claims 1 and 8 have been amended. Accordingly, claims 1-10 are presented and at issue. Entry of this Amendment is respectfully solicited as it will place the present application in condition for allowance.

The Examiner rejected claims 1-10 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,064,887 to Kallioniemi. Before discussing the cited prior art and the Examiner's rejections of the claims in view of that art, it would be helpful to present a brief summary of applicant's claimed invention. One objective of the present invention is to provide a mechanism for controlling a subscriber identity module (for example, a SIM card) connected to a mobile station (page 15, line 6 of the specification), so as to allow for easily updating or changing data in the subscriber identity module. Such a mechanism would enable wireless communication service providers to offer enhanced customer service (refer to page 4, lines 7-12 of the specification). The aforementioned objective is achieved by changing data stored in a subscriber identity module and currently associated with a first subscription. This data is changed into data associated with a second subscription in response to a message received by a mobile station connected to the subscriber identity module. The message is an instruction that specifies the change of data. The foregoing features of applicant's invention are set forth in amended steps (c) and (d) of Claim 1, and are discussed in the specification at page 5, line 19 to page 6, line 4.

In view of the Examiner's rejection, independent claim 1 has been amended to more particularly distinguish applicant's invention from the Kallioniemi patent. Step (c) of claim 1 has been amended to specify the sending of a message through the mobile data communication system to the mobile station. The message is addressed to the first subscription-specific call number, and instructs changing, in the subscription data stored in the subscriber identity module, of the first

subscriber identity code into the second subscriber identity code. Step (d) of claim 1 has been amended to specify that, in response to a receipt of the message at the subscriber identity module attached to the mobile station, the first subscriber identity code is changed into the second subscriber identity code. The subject matter of amended steps (c) and (d) is fully supported by the specification with reference to page 5, line 19 to page 6, line 4.

The features set forth in steps (c) and (d) of claim 1, as amended, are neither disclosed in, nor suggested by, the Kallioniemi patent. Kallioniemi relates to a telecommunications network that permits the mobile subscriber to retain the same subscription-specific call number when changing service providers. Any changes to subscription data are performed in network elements such as a Home Location Register (HLR) or a number portability database (refer to the Abstract of Kallioniemi).

The Examiner alleges that the present invention maintains updated data within an HLR (see Final Office Action, page 5, last paragraph) and, as such, is anticipated by the teachings of Kallioniemi. For support, the Examiner refers to pages 2-6 of the present application. However, pages 2-6 do not disclose maintaining updated data within an HLR. Pursuant to applicant's disclosure, the subscriber identity module is the location where data are updated. A record of data is created in a first subscriber register. This record of data is not changed or updated after its creation. A second record of data is created in a second subscriber register. This second record of data is not changed or updated after its creation. In contrast to the approach taken by Kallioniemi, applicant's claimed invention updates a subscriber identity code included in subscriber data stored in the subscriber identity module from a first identity code to a second identity code, as is clearly set forth in amended steps (c) and (d) of claim 1. Unlike Kallioniemi, the present invention does not involve maintenance of updated data within an HLR.

In the context of mobile data communication, the location at which data is stored oftentimes takes on special significance. Although some items of data stored in the subscriber identity module are the same as corresponding items of data in the home location register, it is important to realize that a subscriber identity module is not just any data storage location. Rather, as is known in the art, the subscriber identity module is a module (such as a smart card) that contains subscription information vital to the operation of a mobile station. The subscriber identity module needs to be connected/attached to the mobile station in order to render the mobile station operable. The mobile data communications system requires data from both locations (the home location register and the subscriber identity module) in order to provide network access to the mobile station. Moreover, the process of updating data stored in the subscriber identity module is independent of the process of updating data stored in a home location register. If data stored in a home location register are updated, this does not automatically result in updating of data stored in a subscriber identity module. Using prior art approaches, the updating of data stored in a subscriber identity module has been very difficult or impossible, as is discussed at page 3, lines 2-13 of the specification. Hence, a subscriber identity module is not analogous to a storage location in a home location register.

In view of the foregoing considerations, it is submitted that claim 1 is neither anticipated by, nor rendered obvious in view of, the Kallioniemi patent. It is further submitted that claims 2-7, which depend from claim 1, are patentable over Kallioniemi for at least the reasons set forth above in connection with claim 1.

Independent claim 8 contains, *inter alia*, limitations as follows: ii) second means for generating a message (SMS) to be directed through said mobile data communication system to said first subscription and instructing a change in the data stored in said subscriber identity module from data corresponding to said first subscription to data corresponding to said second

subscription; and iii) third means for changing the data stored in said subscriber identity module (SIM) from data corresponding to said first subscription to data corresponding to said second subscription. Apparatus limitations ii) and iii) of claim 8 are analogous to the method limitations discussed above in method steps (c) and (d) of claim 1. Note also that claims 9 and 10 depend from claim 8. Accordingly, it is submitted that claims 8-10 are neither anticipated by, nor rendered obvious in view of, the Kallioniemi patent for the same reasons set forth above in connection with claim 1.

Based on the foregoing considerations, it is respectfully submitted that the present invention is clearly and patentably distinguishable over the prior art of record. Accordingly, prompt and favorable action leading to allowance of the present application is earnestly solicited. Note that this Reply is filed within two months of the mailing date of the Office Action. Should the Examiner have any questions, concerns, comments, suggestions, or objections, she is respectfully requested to telephone the undersigned in order to facilitate a resolution of any outstanding issues.

It is believed that no fees or charges are required at this time in connection with the present application; however, if any fees or charges are deemed necessary at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By   
Steven R. Bartholomew  
Reg. No. 34,771  
551 Fifth Avenue, Suite 1210  
New York, New York 10176  
(212) 687-2770

Dated: May 7, 2004